

REMARKS

INTRODUCTION

Claims 1-29 were previously and are currently pending and under consideration.

Claims 10, 11 and 26 are allowed.

Claims 1-9, 12-25 and 27-29 are rejected.

Claims 1, 9, 13, 22 and 27 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

ENTRY OF AMENDMENT UNDER 37 CFR §1.116

Applicant requests entry of this Rule 116 Response because:

- (a) it is believed that the amendment of the claims puts this application into condition;
- (b) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed;
- (c) the amendments of the claims should not entail any further search by the Examiner since **no new features are being added or no new issues are being raised**; and
- (d) the amendments **do not significantly alter the scope of the claims** and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTIONS UNDER 35 USC § 112, SECOND PARAGRAPH

In the Office Action, at pages 2-9, claims 1-9, 12-25 and 27-29 were rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth therein. The Examiner alleged that the claim recitation "ideal working condition" was not clear. The term "ideal" has been removed to broaden the claims. Withdrawal of the rejection is respectfully requested.

The rejection states that "an automatic determination during the simulation that it satisfies an ideal working condition of the working means model is vague and indefinite, since the ideal working condition of the working means model is also vague and indefinite". The entire second paragraph indefiniteness rejection depends on the conclusion that "ideal working condition" is vague and indefinite.

Applicant respectfully notes that according to MPEP § 2173.02, "If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C.112, second paragraph is appropriate, ... an analysis as to why the phrase(s) used in the claim is 'vague and indefinite' should be included in the Office action." The § 112, second paragraph rejection does not provide the analysis required by the MPEP. The rejection states only a conclusion ("since the ideal working condition of the working means model is also vague and indefinite") without any accompanying analysis of why the "ideal working condition" was considered vague or indefinite.

As mentioned above, the MPEP requires that when presenting a §112 second paragraph rejection the PTO must explain why the rejected phrase is considered vague and indefinite. The present §112 second paragraph rejection provides no explanation of why "ideal working condition" is vague or indefinite. The fact that the phrase gave rise to a §112 first paragraph rejection does not prove that the phrase is vague or indefinite. The first and second paragraphs of §112 are distinctly different requirements. A claim or phrase may be unsupported by a specification (not satisfy first paragraph) and yet be clear and precise and satisfy the second paragraph. Conversely, a phrase may be vague and indefinite and yet be fully supported by its specification.

Regardless of the substantive correctness of the present §112 second paragraph rejection, the rejection gives no explanation of why the claim is deemed by the Examiner to be vague and indefinite. The term "ideal" is not vague or indefinite but is rather clear and precise. The Merriam Webster Dictionary indicates that "ideal" can be used to indicate "conforming

exactly to an ideal, law, or standard : PERFECT <an ideal gas>".

Furthermore, as stated in MPEP §2171, "[in making a second paragraph [rejection], the examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention." The rejection does not explain whether the "ideal working condition" is based on indefiniteness or on failure to claim the invention.

In sum, the §112 second paragraph rejection must be withdrawn because it is both incomplete and incorrect.

IMPROPER FINAL OFFICE ACTION: FINALITY OF OFFICE ACTION MUST BE WITHDRAWN

The Office Action was improperly made Final because (1) the §112 second paragraph rejection is incomplete, (2) the Office Action did not respond to each of Applicant's arguments, and (3) the §112 first and second paragraph rejections should not have been made.

(1) Based on the impropriety of the §112 second paragraph rejection, Applicant respectfully requests withdrawal of the finality of the Office Action. The Office Action was prematurely made final because the Examiner has denied the Applicant "a full and fair hearing, and ... a clear issue between applicant and examiner" was not developed (MPEP § 706.07). Without the required explanation having been provided by the Examiner, Applicant cannot respond to the §112 second paragraph rejection. As stated in the MPEP, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity" (MPEP § 706). Applicant has not been given an opportunity to respond to the rejection because its basis is not explained.

(2) Applicant presented an argument in the September 9, 2003 Amendment that the prior art reference Siddique does not discuss or suggest automatic selection of a working means model from among plural working means models, but rather discusses manual selection of a tool or working means model. See page 14 of said Amendment, which states "nor does "[Siddique] suggest automatically finding an ideal tool". The rejection did not respond to Applicant's argument that Siddique discloses only manual tool selection. Whether the term "ideal" is vague or indefinite, Applicant has clearly argued that Siddique differs because it discloses only manual

tool selection. The Applicant has been denied an opportunity to develop a clear issue regarding patentability over the prior art. This opportunity has been denied, despite the Examiner's agreement that "[f]rom the above descriptions in the specification it is understood that the working means model is automatically selected from among plural other working means models pre-associated with the standard part models" (page 4, second paragraph). The Examiner has not stated whether this § 112-satisfying feature distinguishes over the previously-cited prior art.

The Office Action also did not respond to Applicant's arguments because it did not address Applicant's previous remarks relating to the specification's support of "ideal working condition" and other amendments made to the claims. At page 14, lines 3-10 of the September 9, 2003 Amendment, as required by the MPEP, Applicant discussed the specification's support for claim language added therein. The recent Final Office Action and in particular the §112 first paragraph rejection did not respond to Applicant's argument regarding satisfaction of §112 first paragraph. Again, Applicant has improperly been denied an opportunity to develop clear issues regarding the §112 first paragraph rejection.

(3) As shown in the Remarks of this Amendment, the §112 first and second paragraphs are incorrect; the claim amendment at issue is both supported by the specification and is neither vague nor indefinite.

As stated in MPEP § 706.07(d), "If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection." Withdrawal of the premature finality of the Office Action is respectfully requested.

REJECTIONS UNDER 35 USC § 112, FIRST PARAGRAPH

In the Office Action, at pages 2-9, claims 1-9, 12-25 and 27-29 were rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth therein. Withdrawal of the rejection is respectfully requested.

The rejection states at page 4, that (1) "the specification does not describe anywhere that the working means model is automatically selected from among plural other working means models the associated with the standard part model is based on an automatic determination during the simulation that it satisfies an ideal working condition of the working means model",

and (2) "The specification also does not describe what the ideal working conditions are and how it is determined that the simulation satisfies the ideal working conditions." These features are each addressed below.

Regarding the first ground for rejection, the Examiner has acknowledged that the specification does describe automatically selecting a working means model from among plural other working means models associated with the standard part model (page 4, lines 13-15). Therefore, the only issue with respect to the first ground of rejection is whether the specification describes selecting based on an automatic determination during simulation that an ideal working condition is satisfied.

Support for the first feature is found at least at Figure 12 and at pages 63 and 64 of the specification. Figure 12 shows a process for operating a working means model by increments, and at the each increment testing for interference. Step the 23 follows previous routing steps during which the working means model has been maneuvered into position to operate the subject part model. Step the 23 shows calculating a minimum unit working amount such as a rotation amount. For example, the minimum unit working amount could be 60°. Simulation of operation of the working means model begins at step the B24; the working means model is operated by the unit working amount (e.g., it might be rotated by 60°). After step the B24, the simulation checks at step B25 for interference between the working means model and any other model besides the part model (e.g. interference with a design model). If it is determined that no interference occurs then, at step the 26, the simulation checks whether the ideal tool working condition has been satisfied. If the ideal working condition has been satisfied, then the process ends and the current working means model is reported and selected.

An example of an ideal working condition is discussed throughout the specification. In particular, page 59, lines 17-25 discuss an ideal working condition. This portion of the specification notes that "until it is detected by the interference checking section 24 that interference of the working means model with any model other than the subject standard part model occurs or it is detected that a tool ideal working condition is satisfied without suffering from interference, the working means model is successively operated step-by-step by the minimum working amount". This portion of the specification clearly refers to an ideal working condition as a condition of operating the working means model without the occurrence of interference. In the example, the ideal working condition is a range of motion that is tested by a

simulation where successive incremental rotations are made and interference is checked for. Selection of the tool based on this condition occurs at B26; no other tools are selected and the simulation displays the current tool.

See also page 56, line 24 to page 57, line 16, which further elaborates on the need to test whether sufficient working space (sufficient rotation without interference) is available depending on the nature of the tool model. In particular, the specification states that

"when a model 51 of a bolt as a standard part model is to be worked using a model 52 of a spanner as seen in Figure 14, as a working range of the model 52 of a spanner, it is ideal to assure a working space over 360 degrees ... however, such a situation possibly occurs that, due to interference with some other part, the working range can be assured only over a range of, for example, 240 degrees ... In other words, even if a tool model can arrive at the position of a subject standard part model without any interference, it is not guaranteed that the tool model can be used appropriately"

See also pages 60 and 61, which relate to determining a working range and whether an ideal working condition (minimal working range) can be executed without interference.

Regarding the rejection's assertion that the specification does not teach selecting the working means model "based on an automatic determination during the simulation that it satisfies an ideal working condition of the working means model", the Examiner is respectfully directed to Figure 12, step B34, which shows that if "another ... working means model" is "available", then same is called to be used in the simulation process starting at B3, Figure 11. It is clear that the new working means model is chosen at B34 and B36 when a previous working means model does not satisfy the particular working condition (B29) such as a minimal spanning range. Furthermore, in the specification, the working means model selected at B34 and B36 will be ultimately selected at B26 when it is determined that it satisfies the (ideal) working condition such as a minimum spanning range.

The term "ideal" has been removed from the claims only to broaden the claims and to clarify that the working condition satisfied by the selected working means model need not be limited to a subjective preferred working condition, but can also include any working condition for working a standard part model. For example 180 degrees of rotation might be a working condition that is ideal in terms of hand ergonomics or working efficiency, and 5 degrees might be

a minimally sufficient working condition range for example to assure that the working means model can actually operate, for example a ratchet wrench might require 5 degrees of rotation to grip a next ratchet tooth. Or, a torque wrench might require some range of rotation to give a reliable reading. The point is that the claims cover any working condition however determined or provided.

Withdrawal of the rejection is respectfully requested.

CONCLUSION

It is respectfully noted that Applicant's arguments regarding the prior art are still outstanding and have not received a required response.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

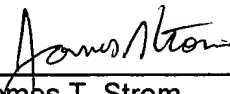
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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